

### **REMARKS/ARGUMENTS**

Claims 1-9, 12, 15-25, 27, 28-30, 32-42, 44, 47-61, and 63-64 are pending. The Office Action rejects all pending claims under 35 U.S.C. §103(a) as unpatentable over Kovlakas (U.S. Patent Pub. 2003/0089765) in view of Sansone (U.S. Patent No. 6,108,643). These rejections are respectfully traversed.

#### **The Office Action Fails to Support a *Prima Facie* Case of Obviousness with Respect to Several Dependent Claims.**

The analysis supporting a rejection under §103 must be made explicit. That is, an obviousness rejection cannot be sustained by mere conclusory statements; there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. M.P.E.P. §§ 2141, 2142 (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 at 1396 (2007)). Where an articulated reasoning to support the legal conclusion is not provided, the examiner fails to make a *prima facie* case of obviousness, and the applicant is under no obligation to produce evidence or argument in favor of patentability. M.P.E.P. §2142. Further, the Office is required to support findings of fact with "substantial evidence." *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000); see M.P.E.P. §2144.03.

The Office Action rejects claims 1, 2, 4-9, 12, 15-25, 27, 29, 30, 32-35, 37-42, 44, 47-61, 63, and 64 as obvious over Kovlakas in view of Sansone. However, the Office Action fails to provide any explanation or analysis of where the references are believed to suggest several features recited in the dependent claims, or why these claims would be obvious to one of skill in the art. Specifically, the Office Action does not indicate where the references allegedly disclose the following features, or why these features would have been obvious:

- the authentication of at least part of the read data requires the at least part of the read data to have a predeterminable format (claims 6, 39);

- separating a section of the postage imprint, the separated section including an authentication code and excluding the sensitive information (claim 12);

- separating a label on which the postage imprint is provided from the spoiled mail item (claim 15);

obliterating the sensitive information (claim 16);  
over-printing the sensitive information (claim 17);  
applying a panel over the sensitive information (claim 18);  
cutting out a section of the spoiled mail item (claim 19);  
generating a spoiled item notification for the spoiled mail item (claim 22);  
an image of the postage imprint associated with the spoiled mail item is  
acquired...and each spoiled item notification includes the image which excludes  
the sensitive information (claim 24);  
writing a postage imprint for a subsequent mail item...the postage imprint  
contains an authentication code contained in the postage imprint of the spoiled  
mail item (claim 27);  
the postage imprint is a radio frequency tag (claim 42); and  
the postage imprint is removable from the mail item (claim 47).

Similar features recited in claims 47-57 are also not addressed by the Office Action. Applicants note that this is not intended to be an exhaustive list, and omission of other features from this list should not be understood to indicate agreement with any analysis presented in the Office Action or to acknowledgement that the omitted feature has been properly and fully addressed by the Office Action.

Since the Office Action fails to indicate where these features are allegedly shown by the cited art or otherwise would have been obvious to one of skill in the art, it fails to provide an articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. Therefore, the Office Action fails to support a *prima facie* case of obviousness at least with respect to these claims, and the rejections should be withdrawn.

**The Cited References Do Not Disclose the Features Recited in the Independent Claims.**

To support a *prima facie* case of obviousness, the Examiner must demonstrate that each feature recited in the claims is found in the cited art, or provide explicit reasoning to support the finding that the features would be obvious to one of skill in the art at the time the invention was

made. See M.P.E.P. §§ 2141, 2142. The Office Action asserts that each feature recited in the claims is explicitly described by the cited references. Applicants respectfully disagree.

Independent claim 1 recites, *inter alia*, a postage imprint associated with a mail item bearing sensitive information, and presenting at least one of the spoiled mail item and the associated postage imprint to a postage service, so that the sensitive information is not readable by the postage service. Independent claim 34 recites similar features.

Kovlakas describes a system in which postage indicia 14, 24 associated with mailpieces 11, 21 can be presented to a kiosk to obtain a refund when the mailer decides not to post the mail pieces 11,21. The kiosk scans the indicia and determines whether to issue a refund. See, e.g., ¶ 0020-23. The Office Action asserts that the destination addresses 12, 32 displayed on mail pieces 11, 21 in Kovlakas' Figures 1 and 2 are sensitive information that is not readable by a postage service when the mail piece is scanned by the kiosk. This is incorrect.

Kovlakas indicates that the kiosk or other device reads the indicia 14, 24 and decides whether to issue a refund based in information obtained from the indicia. Although not stated explicitly, the Office Action appears to take the position that, since the kiosk does not read the recipient address to make this determination, it cannot read it. However, even if the refund devices 53, 58 in Kovlakas do not scan or read the recipient address, which Applicants do not concede, this merely means that they elect not to read the address, not that they are incapable of doing so. Whether or not the refund device does in fact read the address is irrelevant to any consideration of whether the device is capable of reading the address.

In fact, Kovlakas explicitly indicates that the recipient address is readable. Figures 1 and 2 both illustrate the recipient address being printed on the mail piece in plain text. Thus, any entity wishing to – including Kovlakas' refund device or other postage service – is able to read the address. Insofar as the refund device may not actually read or scan the recipient address, it is by design or choice of the device, not because the address is not readable by the device.

Further, before the mailer decides not to post the mail piece in Kovlakas, it is ready to be sent through the postal service for delivery to the recipient. (For example, the mail pieces shown in Figures 1 and 2 are deliverable by the postal service.) This means that the recipient

address must be readable by the postal service, since if it was not readable by the postal service, the service would be unable to deliver the mail piece at all. However, Kovlakas does not indicate or suggest that the address is removed, obscured, obfuscated, encrypted, or otherwise altered before the mail piece is presented to the refund device and, therefore, the recipient address must still be readable by the postal service, refund device, or any other device. For at least these reasons, the Kovlakas contradicts the Office Action's assertion that the recipient address is sensitive information that is not readable by a postage service, and the independent claims are allowable over the cited art.

The dependent claims are allowable at least for the same reasons as the independent claims from which they depend, and are patentable for additional reasons. Withdrawal of the rejections and reconsideration is respectfully requested.

Appl. No. 10/529,272  
Amdt. dated June 2, 2009  
Amendment under 37 CFR 1.116 Expedited Procedure  
Examining Group 2887

PATENT  
Attorney Docket No.: 26978A-002710US  
Client Ref. No.: 59024

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 202-481-9900.

The Commissioner is authorized to charge any fees due or credit any overpayment to the deposit account of Townsend and Townsend and Crew LLP, Deposit Account No. 20-1430.

Respectfully submitted,

/ASKamlay/  
Aaron Kamlay  
Reg. No. 58,813

DATE: June 2, 2009

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 202-481-9900  
Fax: 415-576-0300  
AK:lrđ  
61899061 v1